



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,098	01/18/2000	Albert D. Baker	19-3	9279

7590 07/20/2004  
Ryan & Mason LLP  
90 Forest Avenue  
Locust Valley, NY 11560

EXAMINER

TODD, GREGORY G

ART UNIT PAPER NUMBER

2157

DATE MAILED: 07/20/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

56

**Office Action Summary**

Application No.

09/484,098

Applicant(s)

BAKER ET AL.

Examiner

Gregory G Todd

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Appeal Brief***

1. This is a fourth office action in response to applicant's appeal brief filed, 02 April 2004, of application filed, with the above serial number, on 18 January 2000 in which claims 1-21 are pending in the application.

In view of the Appeal Brief filed on 02 April 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 2157

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim s 1-3, 5-13, and 15-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Bhatia et al (hereinafter "Bhatia", 6,563,824).

Bhatia discloses the invention as claimed including a LAN modem remotely assigning related addresses (see abstract).

As per Claims 1,11 and 21, Bhatia teaches an apparatus, a method, and a machine-readable medium storing one or more programs for use in interfacing a local network to one or more external network elements, wherein Bhatia teaches:

a gateway (LAN modem) coupled between the local network and the one or more external network elements, the gateway being operative to determine remotely-assigned address information for a given device attached to the local network (ISP assigns IP address (eg. 192.168.1.1) to local workstation) (at least col. 6, lines 9-28);

establish, based at least in part on the remotely assigned address information, a substitution address for use by at least one other device attached to the local network when communicating with the given device (other workstations assigned an IP address based on 192.168.1.1, namely 192.168.1.4 and 192.168.1.5 given by the LAN modem) (at least col. 6, lines 9-60).

As per Claims 2 and 12.

the remotely-assigned address information comprises an Internet protocol (IP) address assigned to the at least one device by an external (ISP) network element (at least col. 6, lines 9-28).

As per Claims 3 and 13.

the local network comprises a local area network (LAN / Intranet) (at least Fig. 2C, col. 6, lines 9-12).

As per Claims 5 and 15.

the gateway stores remotely-assigned address information for each of a plurality of devices attached to the local network (tables) (at least col. 11, lines 9-66).

As per Claims 6 and 16.

the gateway stores a set of address substitution information for each of the plurality of devices, the set of address substitution information for a given one of the devices comprising an address to be used by the given device in communicating with the gateway, and addresses to be used by the given device in communicating with each of the other devices (private and public IP address stored in tables) (at least col. 12, lines 51-61; col. 11, lines 9-66)

As per Claims 7 and 17.

the stored information comprises an address substitution matrix having a row of address information for each of the plurality of devices attached to the local network (tables) (at least col. 12, lines 51-61).

As per Claims 8 and 18.

a given one of the sets of address substitution information for a particular one of the plurality of devices comprises a set of IP addresses, each of which is sub-network compatible with an IP address remotely assigned to the corresponding device, such that communications between the given device and another one of the devices attached to

Art Unit: 2157

the local network are not routed through an external network element (private IP addresses never routed beyond LAN) (at least col. 5, lines 25-48).

As per Claims 9 and 19.

the gateway processes a particular received packet in order to replace remotely-assigned address information in a header thereof with a corresponding substitution address determined by the gateway (at least Fig. 5-6; col. 12 line 62 - col. 13 line 25).

As per Claims 10 and 20.

the gateway intercepts at least one of control information and maintenance information received over the local network and associated with the given device so as to perform related services on behalf of the given device (at least col. 10 line 48 - col. 11 line 7).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia in view of Gelman et al (hereinafter "Gelman", 6,493,348).

Bhatia discloses the invention substantially as claimed including a LAN modem remotely assigning related addresses (see abstract).

Art Unit: 2157

Bhatia does not explicitly disclose the gateway comprising an ADSL termination unit-receive device (ADSL modem). However, the use and advantages for using such a modem is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Gelman (at least Gelman col. 6, lines 5-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of specifically an ADSL modem into Bhatia's gateway /LAN modem because this would simply expand the compatibility of the modems used in the gateway (at least col. 4, lines 17-25; col. 7, lines 48-52) with xDSL / ADSL networks and ATU-R's.

### ***Response to Arguments***

6. Applicant's arguments, see pages 4-11, filed 02 April 2004, with respect to the rejection(s) of claim(s) 1-21 under 35 U.S.C. 102 (e) and claims 1, 11, and 21 under 35 USC 112, first paragraph, have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited Arrow et al, Sekine et al, and Slemmer et al, in addition to previously cited RFC 1597, Kracht, Gervais et al, Akatsu et al, Nonaka et al, Hong et al, Zisapel et al, Subramaniam et al, Howes et al, Millet et al, and Weiman as well as newly cited Nonaka et al (packet substitution gateways) and Datta et al (multiple

Art Unit: 2157

routers controllable by address configuring gateway) are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G Todd whose telephone number is (703)305-5343. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory Todd



Patent Examiner

Technology Center 2100



**SALEH NAJJAR**  
**PRIMARY EXAMINER**